

REMARKS

Claims 1-30 were pending in the application. Claim 30 has been cancelled without prejudice to presentation in future related applications. New claims 31-34 have been added. Claims 21, 23, 25-27 and 29 have been added.

The claims were amended to further clarify the claimed invention and to correct previously filed multiply dependent claims. Support for the amendments to the claims as well as for new claims 31-34 can be found throughout the application as originally filed, including, for example, in the as-filed claims, and paragraphs [0330], [0332] and [0337] of the application as filed.¹

No new matter has been added.

Upon entry of this amendment, claims 1-29 and 31-34 will be pending.

Restriction Requirement

Claims 1-30 are subject to a restriction requirement. The Examiner required Applicants to elect one of seven allegedly patentably distinct inventions for examination. Applicants respectfully traverse on the grounds that searching more than one of the groups set forth by the Office would pose no serious burden on the Examiner.

MPEP §803 sets forth criteria for determining when restriction is proper, stating, *inter alia*, that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Applicants respectfully assert that searching more than one group would not constitute a serious burden. For example, Applicants note that several of the groups relate to comparison of levels of DKFZp5661133 expression products. Accordingly, search results for several of the groups would be highly relevant to other groups, and vice versa. Applicants respectfully assert that search and examination of several groups can readily be performed without serious burden.

¹ Paragraph numbering is as set forth in US Published Patent Application 20060141455

Although Applicants respectfully traverse the restriction requirement on the grounds that examining more than one invention would not constitute a serious burden, Applicants provisionally elect herein Group VI, "Claims 21-29, drawn to a method of identifying an agent that modulates a biological activity ... classifiable in classes 536, subclass 24.5, class 424, subclass 134.1, or class 530, subclass 350, for example". New claims 31-34 read on elected Group VI.

Notwithstanding the foregoing, however, as discussed above, Applicants respectfully request that one or more additional groups be examined along with Group VI.

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Related Applications

Applicants call the Examiner's attention to the following related application: 10/948,737 (filed September 22, 2004). This application is available in PAIR and the Examiner is encouraged to review it.

PP017767.0004; 20366-124US1
SERIAL NO.: 10/501,187

PATENT
FILED: January 13, 2006

Conclusion

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Please apply any charges or credits to Deposit Account 06-1050 referencing Attorney Docket No.: 20366-124US1.

Respectfully submitted,



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